

REMARKS

The Examiner has rejected Claim 1 as indefinite due to the terms "protein-wasting immunogen" in the last line of the claim. These terms have been changed to --targeted colony-forming immunogen-- to agree with the targeted colony-forming immunogen defined in line 3 of the claim. This amendment overcomes the rejection of Claim 1 under 35 USC 112. Applicants request that this amendment be entered as it overcomes an informal language noted by the Examiner.

Applicant further request that the rejection of Claims 1, 3 and 5-38 on the ground of "nonstatutory double patenting" be withdrawn. The present application is a division of parent U.S. Application Serial No. 09/616,843. The Examiner in Application Serial No. 09/616,843 made the following restriction requirement under 35 USC 121.

"Restriction to one of the following inventions is required under 35 U.S.C 121:

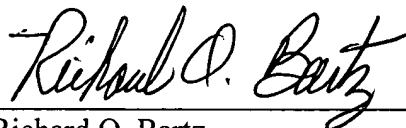
- I. Claims 1-3, method for the production of a microbial adherence inhibitor in the form of egg antibody to food animal, classified in Class 424, subclass 131.1.
- II. Claims 4-9, drawn to drawn to colony-forming immunogen, and microbial adherence inhibitor in the form of fowl egg antibody to food animal, classified in Class 530, subclass 387.1.
- III. Claims 10-11, drawn to method of promoting the growth of food animals by inhibiting the ability of the colony-forming protein-wasting immunogen to the rumen of food animals, classified in Class 424, subclass 826.
- IV. Claims 12-13, drawn to method of reducing or eliminating the incidence of illnesses caused by the presence of targeted colony-forming illness-causing immunogen in meat by inhibiting the immunogen to adhere to the rumen of food animals, classified in Class 424, subclass 826."

The claims in the present application are Group II invention drawn to a method for the production of a microbial adherence inhibitor. In view of the restriction requirement in the Office action of November 9, 2000, Applicants request that the double patent rejection of Claims 1, 3 and 5-38 be withdrawn. A copy of the Office action of November 9, 2000 is enclosed.

Respectfully submitted,

PETER NASH ET AL

By

A handwritten signature in black ink, appearing to read "Richard O. Bartz", written over a horizontal line.

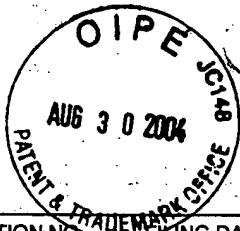
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on August 27, 2004,
(Date of Deposit)

Richard D. BARTZ
Name of applicant, assignee, or Registered Rep.

Richard D. Bartz
Signature

August 27, 2004
Date of Signature



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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/616,843	07/14/00	NASH	P C150.12.3B

L. PAUL BURD
1300 FOSHAY TOWER
MINNEAPOLIS MN 55402

HM12/1109

EXAMINER

HUYNH, P

ART UNIT	PAPER NUMBER
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1644

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Burd, Bartz & Gutenkauf

NOV 20 2000

DATE MAILED:

11/09/00

Received

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary



Application No.

09/616,843

Applicant(s)

NASH ET AL.

Examiner

"Neon" Phuong Huynh

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE One MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-13 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

Art Unit: 1644

DETAILED ACTION

1. The location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1644, Group 1640, Technology Center 1600.
2. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, method for the production of a microbial adherence inhibitor in the form of fowl egg antibody to food animal, classified in Class 424, subclass 131.1.
 - II. Claims 4-9, drawn to drawn to colony-forming immunogen, and microbial adherence inhibitor in the form of fowl egg antibody to food animal, classified in Class 530, subclass 387.1.
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 - IV. Claims 12-13, drawn to method of reducing or eliminating the incidence of illnesses caused by the presence of targeted colony-forming illness-causing immunogen in meat by inhibiting the immunogen to adhere to the rumen of food animals, classified in Class 424, subclass 826.

Art Unit: 1644

The inventions are distinct, each from the other because of the following reasons:

A. Groups II and I/III/IV (antibody and process of using antibody) are related as product and process of use.

The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case, the antibody of Group II can be used as the therapeutic methods as claimed as well as diagnostic/screening, affinity purification assays. Therefore, they are patentably distinct.

B. Groups (I, III and IV) are different methods.

The inventions required different ingredients, process steps and endpoints.

In the instant case, the method of making an antibody to a specific immunogen and the method of using the antibody to vaccinate the food animal. Therefore, they are patentably distinct.

4. Because these inventions are distinct for the reasons given above and the search have acquired a separate status in the art as shown by their different classification that recognized as divergent subject matter, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed in Groups I and III: wherein the protein-wasting immunogen is:

A) *P. anaerobius*,

B) *C. Sticklandii*, or

C) *C. aminophilium*.

And the following patentably distinct species of the claimed Groups I and IV wherein the illness-causing immunogen is:

A) *E. coli*,

B) *Listeria*,

C) *Salmonella* or

D) *Campylobacter*.

Art Unit: 1644

The methods of treating food animals with different immunogen differ with respect to their structure, and mode of action for the different microorganisms. Therefore they are patentably distinct.

6. Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1, 11 and 13 are generic.
7. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

8. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.
9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Art Unit: 1644

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Huynh "NEON" whose telephone number is (703) 308-4844. The examiner can normally be reached Monday through Friday from 8:00 am to 5:00 p.m. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.
11. Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Phuong N. Huynh, Ph.D.
Patent Examiner
Art unit 1644
Technology Center 1600
November 6, 2000

PHILLIP GAMBEL
PHILLIP GAMBEL, PH.D
PRIMARY EXAMINER
RECEIVED CM 1600
11/8/00

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